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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,073	04/20/2001	Todd C. Sacktor	13492	2721

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EXAMINER

PAK, MICHAEL D

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/839,073

Applicant(s)

SACKTOR, TODD C.

Examiner

Michael Pak

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1-10, 12 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11, 13, 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's election with traverse of Group VII, claims 11, 13, and 15 in Paper filed 4 August 2003 is acknowledged. The traversal is on the ground(s) that many of the groups have the same classification and that reliance on classification of the groups of claims does not establish independence and distinctiveness. This is not found persuasive because each invention is drawn to divergent subject matter and requires a separate search in the art. For example group I-IV are drawn to different method of enhancing memory, synaptic transmission, treat brain injury and spinal cord injury which each require a separate search in the art because each topic is found in different journals which treat each subject separately. The pharmaceutical composition requires the separate search of the product in the protein database. The method of treatment of groups VI-IX are with a different compounds than with Groups I-IV. Each group VI—IX is a method of treatment with a different compound from each other which requires a separate search in the art. Classification is one method of determining whether there is a burden of search.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claim 15 is objected to because of the following informalities. Claim 15 is dependent on non-elected claim . Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 13, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are the preamble intended method steps which are needed to fulfill the preamble intended purpose. It is suggested that the claim end with "to said animal" or some other amendment which includes the necessary steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 13 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Thiam et al.(FEBS Letter, 1999).

Thiam et al teach the method of administering palmitoylated modified PCK-ζ pseudosubstrate lipopeptides on HL60 human cells (page 286 and figures 1-3). The claims method step requires administration of a therapeutically effective amount which is met by concentration of 10 uM (page 287-288). The palmitoylated peptide is a

Art Unit: 1646

subgenus of myristoylation peptide meeting the claim limitation of claim 13. The preamble is not referred to in the method step and thus is not part of the claim limitation.

4. No claims are allowed.

5. Examiner suggests these claim languages:

A method of causing amnesia or decreasing synaptic transmission in an animal suffering from a traumatic stress disorder, a phobia, a pain syndrome or epilepsy comprising the administration of a therapeutically effective amount of a PKM ζ inhibitor to said animal wherein the PKM ζ inhibitor is myristolated zeta inhibitory pseudosubstrate peptide.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pak whose telephone number is 571-272-0879. The examiner can normally be reached on 8:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0507.

Art Unit: 1646

Michael D. Pak

Michael Pak

Primary Examiner

Art Unit 1646

February 22, 2004